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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/664,544	09/18/2003	LEO ERNEST MANZER	CL1970USCIP	4273

23906 7590 08/10/2005

E I DU PONT DE NEMOURS AND COMPANY
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EXAMINER

SOLOLA, TAOFIQ A

ART UNIT PAPER NUMBER

1626

DATE MAILED: 08/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/664,544	Applicant(s) MANZER, LEO ERNEST	
	Examiner Taofiq A. Solola	Art Unit 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 20 and 22-26 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) 20 and 22-26 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

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This Office Action supersedes all previous communications.

Claims 20, 22-26 are pending in this application.

The indicated allowability of claims 20, 22-26 is withdrawn in view of the newly discovered reference(s) to e.g. Mallat et al., Applied Surface Sc., (1985), Vol. 40, NO. 4, pages 309-313. Rejections based on the newly cited reference(s) follow.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 20, 22-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Regnier et al., Phytochemistry, Vol. 6, (1967), pages 1281-1289, in view of Mallat et al., Applied Surface Sc., (1985), Vol. 40, NO. 4, pages 309-313.

Applicant claims a process of dihydronepetalactone comprising hydrogenation of nepetalactone in the presence of palladium catalyst supported on a support that is not SrCO_3 . In preferred embodiment the support is carbon, the palladium content is about 0.1 to about 20 weight percent, the reaction is performed in the presence of a metal promoter and temperature range of about 25 to about 250 degrees C and pressure of about 0.1 to about 20 Mpa.

Determination of the scope and content of the prior art (MPEP 2141.01)

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Regnier et al., disclose a process of dihydronepetalactone comprising hydrogenation of nepetalactone. See page 1285, lines 1-12.

Ascertainment of the difference between the prior art and the claims (MPEP 2141.02)

The difference between the instant invention and that of Regnier et al., is that applicant claims any support other than SrCO_3 . Also, Regnier et al do not teach applicant's preferred embodiments.

Finding of prima facie obviousness---rational and motivation (MPEP 2142.2413)

However, Mallat et al., teach palladium catalyst useful for hydrogenation reaction, having carbon support and metal promoter. Claiming palladium content of about 0.1 to about 20 weight percent, temperature range of about 25 to about 250 degrees C and pressure of about 0.1 to about 20 Mpa are obvious modifications available to the special preference of an artisan. They are mere optimization of variables, which are not patentable absent unexpected result due to each variable, which is different in kind and not merely in degree from that of the prior art. *In re Aller*, 22 F.2d 454, 105 USPQ 233 (CCPA, 1955). Therefore, the instant invention is prima facie obvious from the teachings of Regnier et al., and Mallat et al. One of ordinary skill in the art would have known to use carbon as support, a metal promoter in the catalyst of Regnier et al., and optimize the variables at the time the invention was made. The motivation is from the teaching of Mallat et al, that carbon and a metal promoter are useful in palladium catalyst and to maximize the hydrogenation procedure.

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Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taofiq A. Solola, PhD, JD, whose telephone number is (571) 272-0709.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joseph McKane, can be reached on (571) 272-0699. The fax phone number for this Group is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1600.


TAOFIQ SOLOLA
PRIMARY EXAMINER
Group 1626

August 8, 2005

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